

### **REMARKS**

In the office action dated May 6, 2010, claims 1, 3-10, and 12-21 stand allowed. Claim 22 stands rejected as allegedly directed to unpatentable subject matter. In view of the remarks herein, Assignee respectfully contends that claim 22 is directed to statutory subject matter and complies with 35 U.S.C. §101. Reconsideration and allowance are respectfully requested.

#### **Allowable Subject Matter**

The indication of allowable subject matter is gratefully acknowledged.

#### **The Rejection of Claim 22 under 35 U.S.C. §101**

The Office action alleges that the term “A machine-readable storage medium” in claim 22 may read on a wireless channel. However, the claim construction in the Office Action is clearly erroneous. Additionally, because the claimed “machine-readable storage medium” belongs to at least one statutory class, the rejection under 35 U.S.C. §101 is improper.

#### **Requirements for Claim Construction**

According to MPEP 2111, claims are given their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. “This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification.” (Please see MPEP 2111.10).

#### **The Plain Meaning of the Word “Storage” Does Not Embrace Propagating Signals**

The word at issue here is “storage.” As a description of the plain meaning of the term “storage” in the field of electronics, Assignee attaches hereto Appendix A and Appendix B, which are two related printouts (printed on July 6, 2010) from the Merriam Webster Online Dictionary, <http://www.merriam-webster.com/dictionary>. The applicable definition of “storage”

(Appendix A) is 1(c), which refers to meaning 4 of the definition of “memory” (Appendix B): “a device (as a chip) or a component of a device in which information especially for a computer can be inserted and stored and from which it may be extracted when wanted...” If the Examiner believes that this is an inaccurate description of the plain meaning of the word “storage” as it would be interpreted by one skilled in the art, the Assignee respectfully asks that the Examiner provide an alternate meaning believed to be accurate.

Using the above definition, the plain meaning of the term “storage” does not cover a propagating signal, and does not embrace a wireless channel. Applicant also attaches herewith Appendix C, a printout (also from July 6, 2010) from the Merriam-Webster Online Dictionary with the definition of the word “propagate.” The applicable definition of “propagate” is 3: “to travel through space or a material—used of wave energy (as light, sound, or radio waves). Thus, a propagating signal is not stored, and a stored signal is not propagating.

If the Examiner disagrees with the assertion, Assignee again respectfully asks that the Examiner provide supporting documentation in a subsequent action.

The Plain Meaning of “Storage” is Consistent With its Use in the Specification

Storage media are described in paragraph [0021], which defines a “storage medium” as a medium that “may represent one or more devices for storing data, including read only memory (ROM), random access memory (RAM), magnetic disk storage mediums, optical storage mediums, flash memory devices and/or other machine readable mediums for storing information.” This definition is entirely consistent with the plain meaning of the term storage: “storage medium” in general is described as “one or more devices for storing data,” with the examples of “read only memory (ROM), random access memory (RAM), magnetic disk storage mediums, optical storage mediums, flash memory devices,” and a phrase that includes other

storage media not particularly listed: “and/or other machine readable mediums for storing information.” Assignee adds emphasis on the word “storing” to make it clear that a “storage medium” is a particular type of “machine readable medium” that stores information.

Applicant’s use of the word “storage” is consistent with the plain meaning of the word as understood by a person of skill in the art, and does not embrace propagating signals or wireless channels.

For at least the above reasons, the Office Action’s claim construction that a “machine readable storage medium” can read on a propagating signal is not reasonable under MPEP 2111, and is therefore clearly erroneous.

The Office Action Improperly Rejects Claim 22 using the Definition of Machine Readable Medium in Applicant’s Specification Without Consideration of the Meaning of the Word “Storage”

The Office action continues to refer to Applicant’s description of “machine readable medium” in rejecting claim 22, without giving weight to the word “storage.” It is true that the definition of the broad term “machine readable medium” includes an example of a wireless channel. However, the same sentence used against claim 22 clearly teaches that the term “machine readable medium” includes more than storage media: it includes media capable of “storing, containing or carrying instruction(s) and/or data.” As noted in the previous response, a wireless channel is clearly a medium that carries instruction(s) and/or data, and does not store instruction(s) and/or data. If the Examiner alleges that a wireless channel is capable of storing instruction(s) and/or data, Assignee respectfully requests that supporting documentation be provided in a subsequent action.

A Storage Medium Belongs to one or more Statutory Classes

Claim 22, directed to a machine readable storage medium, is at least a manufacture, and is thus a member of a patentable class. On page 3, the Office Action states that “Machine

readable storage medium includes wireless channels which is clearly a signal because stored data can be transmitted through wireless channel, so signal does not within any of the statutory categories, thus, not statutory,” and cites In re Nuijten (500 F.3d 1346, Fed. Cir. 2007) as supporting the rejection under 35 U.S.C. §101. However, as noted in the previous office action, although the Nuijten case held that propagating signals are not statutory, the claims to a storage medium were not even at issue in that case. As noted in Assignee’s previous response:

The cited In Re Nuijten case itself recognizes the difference between storage media and propagated signals. In that case, the Federal Circuit noted that “Finally, Nuijten’s allowed Claim 15 is directed to “[a] storage medium having stored thereon a signal with embedded supplemental data,” where the stored signal has essentially the encoding properties described above. Thus, Nuijten has been allowed claims to the process he invented, a device that performs that process, and a storage medium holding the resulting signals. None of these claims is before us on appeal.” In re Nuijten, 500 F.3d 1346, 1351 (Fed. Cir. 2007, emphasis added).

For at least the above reasons, claim 22 is directed to statutory subject matter, and its rejection under 35 U.S.C. §101 is clearly erroneous. Withdrawal and allowance are respectfully requested.

### CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue, or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

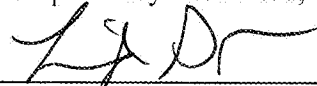
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Dated

July 6, 2010

Respectfully submitted,


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# Appendix A



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## storage

4 entries found.


- storage** (noun)
- storage battery** (noun)
- cold storage** (noun)
- pumped storage** (noun)

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Main Entry: **stor-age** 

Pronunciation: /ˈstɔr-ij/

Function: *noun*


Date: circa 1613

**1 a** : space or a place for storing **b** : an amount stored  
**c** : **MEMORY** 4

**2 a** : the act of storing : the state of being stored;  
*especially* : the safekeeping of goods in a depository  
(as a warehouse) **b** : the price charged for keeping  
goods in a storehouse

**3** : the production by means of electric energy of  
chemical reactions that when allowed to reverse  
themselves generate electricity again without serious  
loss

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







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**MLA Style**  
"storage." Merriam-Webster Online Dictionary. 2010.  
Merriam-Webster Online. 6 July 2010  
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**APA Style**  
storage. (2010). In *Merriam-Webster Online Dictionary*.  
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## memory

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**memory lane** (noun)  
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Main Entry: **mem-o-ry** 4

Pronunciation: \mem-rē, 'me-mə-

Function: *noun*

Inflected Form(s): *plural mem-o-ries*

Etymology: Middle English *memorie*, from Anglo-French *memoire*, *memorie*, from Latin *memoria*, from *memor* mindful; akin to Old English *gemimor* well-known, Greek *memōra* care, Sanskrit *smarati* he remembers

Date: 14th century

**1 a** : the power or process of reproducing or recalling what has been learned and retained especially through associative mechanisms **b** : the store of things learned and retained from an organism's activity or experience as evidenced by modification of structure or behavior or by recall and recognition

**2 a** : commemorative remembrance <erected a statue in memory of the hero> **b** : the fact or condition of being remembered <days of recent memory>

**3 a** : a particular act of recall or recollection **b** : an image or impression of one that is remembered <fond memories of her youth> **c** : the time within which past events can be or are remembered

**4 a** : a device (as a chip) or a component of a device in which information especially for a computer can be inserted and stored and from which it may be extracted when wanted; *especially* : **RAM** **b** : capacity for storing information <512 megabytes of memory>

**5** : a capacity for showing effects as the result of past treatment or for returning to a former condition ---used especially of a material (as metal or plastic)

**synonyms** **MEMORY**, **REMEMBRANCE**, **RECOLLECTION**, **REMINISCENCE** mean the capacity for or the act of remembering, or the thing remembered. **MEMORY** applies both to the power of remembering and to what is remembered <gifted with a remarkable *memory*> <that incident was now just a distant *memory*>. **REMEMBRANCE** applies to the act of remembering or the fact of being remembered <any *remembrance* of his deceased wife was painful>. **RECOLLECTION** adds an implication of consciously bringing back to mind often with some effort <after a moment's *recollection* he produced the name>. **REMINISCENCE** suggests the recalling of usually pleasant incidents, experiences, or feelings from a remote past <my grandmother's *reminiscences* of her Iowa girlhood>.

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1. Memory loss (2 images)

Memory loss (amnesia) is unusual forgetfulness.

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Main Entry: **prop-a-gate**

Pronunciation: \ˈprā-pə-ˌgāt\

Function: *verb*

Inflected Form(s): **prop-a-gat-ed**; **prop-a-gat-ing**

**Eymology:** Latin *propagatus*, past participle of *propagare* to set slips, propagate, from *propages* slip, offspring, from *pro-* before + *pangere* to fasten — more at **PRO-**, **PACT**

Date: circa 1570

*transitive verb*

**1** : to cause to continue or increase by sexual or asexual reproduction

**2** : to pass along to offspring

**3 a** : to cause to spread out and affect a greater number or greater area : **EXTEND** **b** : to foster growing knowledge of, familiarity with, or acceptance of (as an idea or belief) : **PUBLICIZE** **c** : to transmit (as sound or light) through a medium

*intransitive verb*

**1** : to multiply sexually or asexually

**2** : **INCREASE**, **EXTEND**

**3** : to travel through space or a material —used of wave energy (as light, sound, or radio waves)

— **prop-a-ga-tive** \-ˌgā-tiv\ *adjective*

— **prop-a-ga-tor** \-ˌgā-tər\ *noun*

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"propagate." *Merriam-Webster Online Dictionary*. 2010.

Merriam-Webster Online. 6 July 2010

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propagate. (2010). In *Merriam-Webster Online Dictionary*.

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